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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

UNGAR, SUSAN NMN

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 12/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.



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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

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Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 11/27/01 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
 - c. ☐ They raise the issue of new matter. (See Note).
 - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the request for reconsideration has been entered and the status of the claims will be as follows:

Claims allowed: None
Claims objected to: None
Claims rejected: 1, 4, 5, 11, 12 + 33

However;

☒ Applicant's response has overcome the following rejection(s): 112 and Rejection drawn to "essentials"

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because See attached

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

SUSAN UNGAR, PH.D
PRIMARY EXAMINER

Art Unit: 1642

1. Claims 1, 4, 5, 11, 12 and 33 remain rejected under 35 USC 112, first paragraph for the reasons previously set forth in Paper No. 11, Sections 4-5, pages 2-3 and Paper No. 8, Sections 4-5, pages 2-10.

Applicant argues that the relevant art fields are sufficiently predictable that the present disclosure satisfies all of the requirements of 35 USC 112, first paragraph and that the art is drawn to the field of peptide biology and that the single specific example supports and enables the claims directed to the genus in which the example resides. The argument has been considered but has not been found persuasive for the reasons previously set forth drawn to the unpredictability of making/using a functional pentamer as broadly claimed in view of the lack of written description in the specification as originally filed.

Applicant argues that Example 5 on page 16, paragraph 1, teaches Pab-S as another example of a pentamer and the skilled artisan is able to recognize oligomerization domains. The argument has been considered but has not been found persuasive because Pab-S is a construct based on a COMP pentamerization domain (see p. 11 of the specification) and for the reasons previously set forth the specification lacks written description of the claimed invention and does not enable the broadly claimed invention since, other than the COMP pentamerization domain, the specification does not teach how to make a domain that is functional in the construct claimed.

Applicant argues that the specification teaches that the oligomerization domain should be derived from a peptide that is known for its tendency to oligomerize (and cites paragraph bridging pages 2-3) and that the specification

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provides sufficient detail to enable the skilled artisan to select additional oligomeric domains with a reasonable expectation of obtaining a useful embodiment of the present invention (and cites page 5, para 2 and Example 5, beginning on page 15). The arguments have been considered but have not been found persuasive because although a review of the paragraph bridging pages 2-3 does reveal that the oligomerization domain should be derived from a peptide known for its tendency to oligomerize like COMP, the specification does not convey with reasonable clarity to those skilled in that art that, as of the filing date sought, he or she was in possession of the invention as claimed or as hypothetically suggested in the cited paragraph. Further a review of page 5, paragraph 2 and Example 5 reveals that both are drawn to COMP or modified COMP oligomerization domains.


Applicant argues that, as drawn to linkers, the present claims are limited to proline rich spacer domains that prevent formation of secondary elements and provide a fixed 3-D structure and cites page 4, paragraph 1. The argument has been considered but has not been found persuasive because Applicant is arguing limitations not recited in the claims as presently constituted. Although a review of page 4 reveals support for a proline-rich sequence of a spacer which is "supposed to prevent formation of secondary structure elements and as a consequence, a fixed 3-D structure", this wording is somewhat different than that of Applicant's argument. Further, Applicant is reminded that the claims define the subject matter of his invention and that the specification cannot be relied upon to read limitations into the claims. Arguments presented that rely on particular distinguishing features are not persuasive where the features are not recited in the claims.

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3. Claims 11 remains rejected under 35 USC 112, second paragraph for the reasons previously set forth in Paper No. 11, Section 6, page 3 and Paper No. 8, Section 6, page 10.

It is noted that due to an inadvertent typographical error, the rejection of claim 11 was maintained under 35 USC 112, first paragraph. However, given the content of the maintained rejection and the reference to Paper No. 8, Section 6, page 10, it is clear that the rejection was maintained under 35 USC 112, second paragraph and that no new issues were raised by this inadvertent typographical error.

Applicant argues that the patent applicant can be his/her own lexicographer and that the meaning in this application is clearly the same as the meaning given in the Kajava paper. The argument has been considered but has not been found persuasive because while Applicant can be his/her own lexicographer, it is required that the term be unambiguously defined and for the reasons previously set forth, it is not. Further, the Kajava paper is not incorporated by reference into the instant specification and it cannot be determined whether the construct of Kajava is the construct claimed. Although the Slavin and Strober 1978 paper (page 3) is cited as revealing the pentamerization domain of COMP a review of the paper reveals that it is drawn to spontaneous murine B-cell leukaemia and that it does not reveal characterization of COMP that would be sufficient to unambiguously define the claimed COMP.


SUSAN UNGAR, PH.D
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